

effects (See p.1 of the present specification). Where is the incentive in the teachings of Ercoli et al to produce the 17-butyrate, 21-propionate hydrocortisone claimed here? No 17-butyrate, 21-propionate diester of any steroid compound is disclosed by Ercoli et al. The teachings of Ercoli et al with regard to mixed diesters, generally, (col 4, lines 43-52) tell us little if anything about the therapeutic effectiveness of the mixed diesters and certainly nothing that would provide incentive to produce the claimed diester. Again it is emphasized that no 17-butyrate, 21-propionate diester of any steroid is disclosed nor is any diester of hydrocortisone disclosed. Accordingly, it is submitted that the requisite motivation to make the claimed compound is lacking in the reference. The issue lies in whether it was obvious to make the claimed compound, "not in whether it was obvious how to make [it] once[its] desirability was ascertained." In re Ceson, 177 USPQ 266(CCPA 1973). Thus, the Examiner's remarks regarding the reference teachings as to "how to make" are not regarded as addressing the issue.

With regard to the secondary references, the Examiner writes:

The secondary references disclose the process for making 17-mono esters and 17,21 di-esters of anti-inflammatory steroids and the fact that the new esters have an anti-inflammatory action on topical activity far superior to the unacylated compounds.

Elks et al disclose certain halogen-substituted 17,21-orthoesters, the orthoester group being a closed ring, which are said to have enhanced anti-inflammatory activity as compared to their 17,21-dihydroxy parent compounds (col 1, lines 32-42). While the

Thus, unusual events combined to deny the undersigned any reminder, subsequent to October 16th of the October 29th deadline for response and the failure to file a timely response became unavoidable.

Given a reminder, the response could have been timely filed. In fact, a draft of the response was completed on October 29 and could have been typed and filed on that day had the undersigned been aware of the deadline.

It is, therefore, respectfully urged that the delay in filing the attached amendment be held to be unavoidable and that the instant application be restored to the pending files.

The fee of \$15.00 is transmitted herewith.

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Respectfully submitted,

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